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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/685,590      | 10/16/2003  | Cemal Shener         | 00167-460001        | 5126             |

7590 11/16/2005  
Joel R. Petrow, Esq.  
Chief Patent Counsel  
Smith & Nephew, Inc.  
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EXAMINER

LEUBECKER, JOHN P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3739

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/685,590

Applicant(s)

SHENER ET AL.

Examiner

John P. Leubecker

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3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 19-30 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/24/04, 3/8&amp;8/5/05</u> | 6) <input type="checkbox"/> Other: _____  |

***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “175” has been used to designate both inflow port and L-shaped channels. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

2. The disclosure is objected to because of the following informalities: reference numeral “175” is used to describe two different elements (e.g., note at least pages 6 and 7).

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 29, "the operative device" (line 5) lacks antecedent basis. For the purposes of examination, it will be assumed that the recitation of "operative device" was meant to be functional (i.e., "an operative device").

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-14 and 19-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Glowa et al. (U.S. Pat. 6,086,542).

Glowa et al. discloses an inner portion (30) defining an operative channel (42) and an optical channel (36) and a sheath (60) surrounding the inner portion to define a pressure-sensing channel (52) and a fluid channel (62), both channels being defined between the sheath and inner portion (Fig.2). Channel (52) extends to a port (18, Fig.3), such port capable of communicating with a pressure sensor. Thus, channel (52) is "configured to communicate with a pressure-sensor (for that matter, all the channels are). Furthermore, with respect to claim 24, such port (18) will, if properly connected, maintain its connection no matter how the port is rotated. As to claims 2, 3, 22 and 23, any of the channels are capable of hosting a fluid and thus provide a fluid path. As to claims 4 and 5, the inner wall of inner portion (30) is cylindrical and encloses the channel formed thereby, thus being configured to receive an operative device. As to claim 6, although the embodiment described above (Fig.2) will not suffice, Figure 7 shows an alternative

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embodiment wherein the walls forming the channels (302,304,308) comprise the inner portion and wall (300) forms the sheath which defines two channels (306,306) between the sheath and inner portion. In this embodiment, two cylindrical inner walls define the two channels of the inner portion and the channels are enclosed by the inner portion. Going back to the embodiment of Figure 2, as to claims 8, 19 and 20, the pressure sensing channel (52) is spatially segregated from the other channels (Fig.2). As to claims 9 and 10, all elements are separately interfit to be integral (Fig.2). As to claims 11 and 12, the longitudinal axes of the inner portion (30) and sheath (60) align (Fig.2) and their interfitting cylindrical structures (e.g., "elements") provide this alignment. As to claim 13, note apertures (44) and (66). As to claim 14, note Figure 2. As to claim 21, the operative channel is cylindrical (Fig.2) and thus radially symmetric. As to claim 25, note port (20, Fig.3). As to claim 26, note hub in Figure 3. As to claim 27, the method steps are realized by use and operation of the device of Glowa et al. Concerning the step of connecting a light source, the Examiner takes the position that one of ordinary skill would understand that this step is inherent to use of a scope (36). The structure of claims 28-30 are discussed above.

7. Claims 1-17, 19-26, and 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Vukovic (U.S. Pat. 4,369,768).

Vukovic discloses an inner portion (31,42,45) defining an operative channel (44) and an optical channel (28) and a sheath (30) surrounding the inner portion (Fig.3) to define a pressure-sensing channel (upper channel 38) and a fluid channel (lower channel 38), both being defined between the sheath and inner portion. Since any of the channels are capable of being connected

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to a pressure sensor, they are “configured” to. Other recited elements can be seen in Figures 2 and 3. Noteworthy are the circumferential slot and O-ring (col.3, lines 17-22, Fig.2) which anticipate elements for alignment (claims 11 and 12) (not to mention the shape and interfitting of the of the sheath and inner portion along the longitudinal axis), the fact that the sheath is flush with the distal end of the inner portion (Fig.2) (claim 15), a circular rim (note circular portions of (31)) which is in direct contact with the sheath (note Fig.3) (claim 16), and a first cylindrical portion (e.g., 31,45) having a first diameter and a second rim portion (connector 39, Fig.2) attached to the first cylindrical portion and having a second diameter larger than the first outer diameter (Fig.2 shows difference in diameters) (claim 17).

#### *Allowable Subject Matter*

8. Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Due to the overly broad claims, the Examiner will only cite a few of the more relevant references with respect to the claims as they now appear.

Todd (US 2005/0043690)

Kikawada (U.S. Pat. 5,637,075)

Franssica et al. (U.S. Pat. 5,483,951)

Takahashi (U.S. Pat. 5,257,617)

Crawford (U.S. Pat. 5,944,654)

Rudischhauser (U.S. Pat. 6,471,639)

Muller (US 2003/0130565)

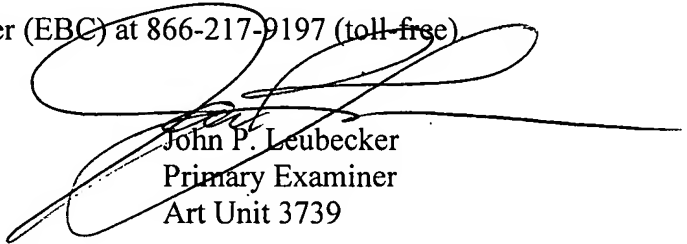
Curtiss (U.S. Pat. 3,939,839)

Karasawa et al. (U.S. Pat. 5,575,756)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl